

Remarks

Applicant respectfully requests that the present remarks be entered and made of record in the instant application. Reconsideration of this Application is respectfully requested. Based on the following remarks, Applicant respectfully requests that the Examiner reconsider all outstanding rejections and that they be withdrawn.

The Claims

According to the Office Action dated August 16, 2005 claims 16-20, 22 and 24-31 are pending in the application. Applicant have cancelled claims 16 and 17, amended claims 18-20, 22, 24 and 25 and added claims 32-35 to clarify the subject matter of the claimed invention.

I. Claim Amendments

The added claims are supported throughout the specification, thus no new matter has been added by way of amendment. Support for new claim 32 can be found throughout the specification (*e.g.*, pages 6-7 and 17; figures 2, 3 and 4; and the originally filed claims). Support for new claims 33 and 34 can be found throughout the specification (*e.g.*, pages 6-7 and the originally filed claims). Support for new claim 35 can be found throughout the specification (*e.g.*, pages 6-7 and 12 and the originally filed claims).

II. Claim Rejections Under 35 U.S.C. § 103

The Examiner has rejected claims 16-20, 22 and 24-31 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,876,946 (Burbaum *et al.*) in view of U.S. Patent

No. 6,248,520 (Roeder *et al.*), and further in view of U.S. Patent No. 6,054,295 (Fang *et al.*).
See Office Action, page 4. Applicant respectfully traverses this rejection.

The Examiner has not established a *prima facie* case of obviousness. The Examiner bears the burden of establishing a *prima facie* case of obviousness based upon the prior art. (*See* the Manual of Patent Examining Procedure (MPEP) § 706.02(j) Rev. 3, August 2005).

The MPEP further states that to establish a *prima facie* case of obviousness, *inter alia*, “there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.” *See* MPEP § 706.02(j) and *In re Lee* (277 F.3d 1338, 1343 (Fed. Cir. 2002)). The Examiner has neither pointed to any suggestion or motivation in the references nor provided the motivation or reason a skilled artisan (with no knowledge of the claimed invention) would have selected these components for combination in the manner claimed.

The Examiner alleges:

[t]he motivation and expectation of success is provided in the ‘946 patent which discloses that the support may also be coated with a recombinantly produced receptor, or receptor binding domain. This is particularly advantageous for receptors or domains that are not normally expressed on the cell surface. For example, nuclear receptors, such as steroid receptors, are advantageously expressed recombinantly, and employed in the microbead assay of the invention. (Column 7, lines 8-15).

Office Action, page 5.

Applicant does not understand how this provides a motivation or suggestion to combine the references to arrive at Applicant’s presently claimed invention. The statement

appears to reflect that Burbaum *et al.* believe their microbead assay might be particularly advantageous for nuclear receptors. This does not provide one skilled in the art with any motivation or suggestion to arrive at Applicant's currently claimed invention. Further, it does not lead one skilled in the art to combine Burbaum *et al.* with Roeder *et al.* or Fang *et al.* to arrive at Applicant's claimed invention.

In addition to a motivation to combine references, all the claim limitations must be taught or suggested by the prior art in order for a claim to be rendered obvious under 35 U.S.C. § 103(a). *See In re Royka*, 490 F.2d 981, 984 (CCPA 1974) and MPEP § 2143.03. The references cited by the Examiner do not teach all of the elements in the present claims. As examples, the cited references do not teach 1) fluorescent polarization (FP) or an assay where FP is measured, 2) fluorescently-labeled steroid hormone receptor ligands, or 3) the combination of steps related to Applicant's presently claimed invention. Since the Examiner has not provided evidence that all the claim limitations are taught or suggested by the prior art, a *prima facie* case for obviousness has not been established. *See In re Royka*, 490 F.2d 981 (CCPA 1974) and MPEP § 2143.03.

In addition, the prior art can not be modified or combined to reject claims as *prima facie* obvious, unless there is a reasonable expectation of success. *See In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). The references cited by the Examiner do not provide a reasonable expectation of success with regards to Applicant's presently claimed invention. For example, since the references do not provide all of the elements of the presently claimed invention, they can not provide one skilled in the art with any reasonable expectation of success of arriving at the claimed invention.

Applicant respectfully submits that, with regard to Applicant's claimed invention 1) there is no motivation or suggestion to combine the references cited by the Examiner, 2) these cited references do not teach all of the elements in the present claims and 3) these references do not provide a reasonable expectation of success. Therefore, the Examiner has not established a *prima facie* case of obviousness and Applicant respectfully requests that the Examiner reconsider and withdraw the rejection under 35 U.S.C. § 103(a).

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. Applicant believes that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in a condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Reply is respectfully requested.

Respectfully submitted,

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